

## **REMARKS**

Claims 1-58 are present in the application. Of those claims, claims 11, 12, and 54-58 have been withdrawn from consideration on the merits as being directed to non-elected subject matter. Office Action at 2. Thus, claims 1-10 and 13-53 are pending and have been examined on the merits. For at least the reasons outlined below, Applicant respectfully submits that claims 1-10 and 13-53 are patentably distinguishable from the references relied on in the claim rejections included in the Office Action, and thus, Applicant respectfully requests reconsideration and withdrawal of the claim rejections.

### **I. Claim Rejection under 35 U.S.C. § 103(a) based on Golley**

Claims 1-10 were rejected under 35 U.S.C. § 103(a) based on U.S. Pat. App. Pub. No. US 2003/0164117 A1 to Golley et al. ("Golley"). Id. Claims 1 and 5 are the independent claims included in this claim rejection, and Applicant respectfully submits that Golley fails to render independent claim 1 or independent claim 5 *prima facie* obvious. Golley fails to disclose all of the subject matter recited in those claims, and the rejection statement fails to explain how the recited subject matter not disclosed in Golley is *prima facie* obvious. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1 and 5 under 35 U.S.C. § 103(a) based on Golley.

According to the M.P.E.P., in order to establish a *prima facie* case of obviousness, the record must "include[] findings of fact concerning the state of the art and the teachings of the references . . . ." Id. § 2141(*II*) (citations omitted). If it is found

that the prior art references fail to disclose all of the subject matter recited in a claim, the rejection statement “must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” Id. § 2141(III).

Applicant respectfully submits that Golley fails to disclose all of the subject matter recited in each of independent claims 1 and 5. Further, the rejection statement fails to explain why the recited subject matter not disclosed in Golley would have been obvious to one of ordinary skill in the art.

**A. Independent Claim 1**

Independent claim 1 is directed to “[a] composition comprising pulverized hydrous kaolin . . . .” Golley does not disclose pulverized hydrous kaolin, and the rejection statement fails to explain why pulverized hydrous kaolin would have been obvious to one of ordinary skill in the art. Indeed, the rejection statement neither asserts that Golley discloses pulverized hydrous kaolin nor asserts that it would have been obvious to one of ordinary skill in the art to pulverize the compositions disclosed in Golley.

According to exemplary embodiments of the present application, pulverized hydrous kaolins having a defined particle size distribution can afford a rapid dispersion in both aqueous and non-aqueous media. (Specification at p. 2, ¶ [020]). For example, in Example 3 dispersion rates of non-pulverized, spray-dried feeds were measured and compared directly to corresponding pulverized samples C and D. (Specification at p. 5, ¶ [0054]). The dispersion rates were measured with a Hegman Grind gauge. Id. As shown in Table VIII, the pulverized samples have higher dispersion rates than the

corresponding non-pulverized samples. (Specification at p. 5, ¶ [0055]). Examples 4 and 5 reinforce the results of Example 3. (See Specification at 5, ¶ [0056], through p. 6, ¶ [0061]).

As outlined above, pulverized hydrous kaolins having a defined particle size distribution may exhibit higher dispersion rates than non-pulverized kaolins. This characteristic may be desirable when hydrous kaolins are used in, for example, paints, where reducing agglomerate formation is desirable. Higher dispersion rates help reduce agglomerate formation, and thus, pulverized hydrous kaolins may be desirable for use in products such as paints.

In contrast, Golley does not disclose pulverized hydrous kaolins. Further, Golley discloses kaolin clay pigments suited for use in rotogravure printing. In applications such as rotogravure printing, reducing agglomerate formation is not as critical as for products such as paints. Thus, not only does Golley fail to expressly disclose pulverized hydrous kaolin, it would not have been obvious to one of ordinary skill in the art to pulverize the kaolin disclosed in Golley in order to achieve higher dispersion rates.

For at least the above-outlined reasons, independent claim 1 is not *prima facie* obvious based on Golley. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claim 1 based on Golley. Claims 2-4 depend from independent claim 1. Thus, claims 2-4 are patentably distinguishable from Golley for at least the same reasons as independent claim 1, and Applicant respectfully requests reconsideration and withdrawal of the rejection of those claims based on Golley.

**B. Independent Claim 5**

Independent claim 5 is directed to “[a] composition comprising hydrous kaolin, wherein the hydrous kaolin has . . . a Hegman grind of more than about 2 in 3 minutes using ‘SSM’ V-T Alkyd Hegman Test.” Golley does not disclose hydrous kaolin having a Hegman grind of more than about 2 in 3 minutes using “SSM” V-T Alkyd Hegman Test. Indeed, the rejection statement neither asserts that Golley discloses such a hydrous kaolin nor asserts that it would have been obvious to one of ordinary skill in the art to modify the compositions disclosed in Golley to have the recited Hegman grind.

For at least these reasons, independent claim 5 is not *prima facie* obvious based on Golley. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claim 5 based on Golley. Claims 6-10 depend from independent claim 5. Thus, claims 6-10 are patentably distinguishable from Golley for at least the same reasons as independent claim 5, and Applicant respectfully requests reconsideration and withdrawal of the rejection of those claims based on Golley.

**II. Claim Rejection under 35 U.S.C. § 103(a) based on Golley and Pavlin**

Claims 13-23 and 47 were rejected under 35 U.S.C. § 103(a) based on Golley in combination with U.S. Patent No. 4,711,927 to Pavlin et al. (“Pavlin”). Office Action at 4. Claims 13 and 47 are the independent claims included in this claim rejection, and Applicant respectfully submits that Golley and Pavlin, regardless of whether they are viewed individually or as a whole, fail to render independent claim 13 or independent claim 47 *prima facie* obvious. Golley and Pavlin fail to disclose all of the subject matter

recited in those claims, and the rejection statement fails to explain how the recited subject matter not disclosed in Golley and Pavlin is rendered *prima facie* obvious. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 13 and 47 under 35 U.S.C. § 103(a) based on Golley and Pavlin.

**C. Independent Claim 13**

Independent claim 13 is directed to “[a]n ink comprising . . . hydrous kaolin, wherein the hydrous kaolin has . . . a Hegman grind of more than about 2 in 3 minutes using ‘SSM’ V-T Alkyd Hegman Test.” As outlined above with respect to the rejection of independent claim 5, Golley does not disclose at least this subject matter recited in independent claim 13. Pavlin fails to overcome the above-noted deficiencies of the rejection of independent claim 5. Moreover, the rejection statement fails to assert either that Golley and/or Pavlin discloses such a hydrous kaolin or that it would have been obvious to one of ordinary skill in the art to modify the compositions disclosed in Golley or Pavlin to have the recited Hegman grind.

For at least these reasons, independent claim 13 is not *prima facie* obvious based on Golley and Pavlin. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claim 13 based on Golley and Pavlin. Claims 14-23 depend from independent claim 13. Thus, claims 14-23 are patentably distinguishable from Golley and Pavlin for at least the same reasons as independent claim 13, and Applicant respectfully requests reconsideration and withdrawal of the rejection of those claims.

**B. Independent Claim 47**

Independent claim 47 is directed to “[a]n ink comprising . . . pulverized hydrous kaolin . . . .” For the reasons outlined above with respect to independent claim 1, Golley does not disclose pulverized hydrous kaolin. Pavlin also fails to disclose pulverized hydrous kaolin. Moreover, the rejection statement fails to explain why pulverizing the compositions disclosed in Golley or Pavlin would have been obvious to one of ordinary skill in the art.

For at least the above-outlined reasons, independent claim 47 is not *prima facie* obvious based on Golley and Pavlin, regardless of whether those references are viewed individually or as a whole. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claim 47 based on Golley and Pavlin.

**III. Claim Rejection under 35 U.S.C. § 103(a) based on Golley and Sare**

Claims 24-33, 48, and 51 were rejected under 35 U.S.C. § 103(a) based on Golley in combination with U.S. Pat. App. Pub. No. US 2002/0088376 A1 to Sare et al. (“Sare”). Office Action at 5. Claims 24, 48, and 51 are the independent claims included in this claim rejection, and Applicant respectfully submits that Golley and Sare, regardless of whether they are viewed individually or as a whole, fail to render independent claims 24, 48, or 51 *prima facie* obvious. Golley and Sare fail to disclose all of the subject matter recited in those claims, and the rejection statement fails to explain how the recited subject matter not disclosed in Golley and Sare is rendered *prima facie* obvious. Therefore, Applicant respectfully requests reconsideration and

withdrawal of the rejection of independent claims 24, 48, and 51 under 35 U.S.C.

§ 103(a) based on Golley and Sare.

**A. Independent Claim 24**

Independent claim 24 is directed to “[a] paint comprising . . . hydrous kaolin, wherein the hydrous kaolin has . . . a Hegman grind of more than about 2 in 3 minutes using ‘SSM’ V-T Alkyd Hegman Test.” For at least the reasons outlined above with respect to independent claim 5, Golley fails to disclose or render obvious at least this subject matter recited in independent claim 24. Sare fails to overcome the above-noted deficiencies of the rejection of independent claim 5 based on Golley. For at least these reasons, independent claim 24 is not *prima facie* obvious based on Golley and Sare. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claim 24 based on Golley and Sare. Claims 25-33 depend from independent claim 24. Thus, claims 25-33 are patentably distinguishable from Golley and Sare for at least the same reasons as independent claim 24, and Applicant respectfully requests reconsideration and withdrawal of the rejection of those claims.

**B. Independent Claim 48**

Independent claim 48 is directed “[a] paint comprising . . . pulverized hydrous kaolin . . . .” For the reasons outlined above with respect to independent claim 1, Golley does not disclose pulverized hydrous kaolin. Sare fails to overcome the above-noted deficiencies of the rejection of independent claim 1 based on Golley. For at least these reasons, independent claim 48 is not *prima facie* obvious based on Golley and Sare.

Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claim 48 based on Golley and Sare.

**C. Independent Claim 51**

Independent claim 51 is directed to “[a] coating comprising pulverized hydrous kaolin . . . .” For the reasons outlined above with respect to independent claim 1, Golley does not disclose pulverized hydrous kaolin. Sare fails to overcome the above-noted deficiencies of the rejection of independent claim 1 based on Golley. For at least these reasons, independent claim 51 is not *prima facie* obvious based on Golley and Sare. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claim 51 based on Golley and Sare.

**IV. Claim Rejection under 35 U.S.C. § 103(a) based on Golley and Pruett**

Claims 34-36 and 49-53 were rejected under 35 U.S.C. § 103(a) based on Golley in combination with U.S. Patent No. 6,564,199 to Pruett et al. (“Pruett”). Office Action at 6. Claims 34, 37, 43, and 49-53 are the independent claims included in this claim rejection, and Applicant respectfully submits that Golley and Pruett, regardless of whether they are viewed individually or as a whole, fail to render any of those independent claims *prima facie* obvious. Golley and Pruett fail to disclose all of the subject matter recited in those claims, and the rejection statement fails to explain how the recited subject matter not disclosed in Golley and Pruett is rendered *prima facie* obvious. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 34, 37, 43, and 49-53 under 35 U.S.C. § 103(a) based on Golley and Pruett.



**A. Independent Claims 34, 37, and 43**

Independent claims 34, 37, and 43 are directed to “[a] polymer product comprising hydrous kaolin,” “[a] rubber product comprising hydrous kaolin,” and “[a] coating comprising hydrous kaolin,” respectively, “wherein the hydrous kaolin has . . . a Hegman grind of more than about 2 in 3 minutes using ‘SSM’ V-T Alkyd Hegman Test.” For at least the reasons outlined above with respect to independent claim 5, Golley fails to disclose or render obvious at least this subject matter recited in independent claims 34, 37, and 43. Pruett fails to overcome the above-noted deficiencies of the rejection of independent claim 5 based on Golley. For at least these reasons, independent claims 34, 37, and 43 are not *prima facie* obvious based on Golley and Pruett. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claims 34, 37, and 43 based on Golley and Pruett. Claims 35, 36, 38-42, and 44-46 depend from a corresponding one of independent claims 34, 37, and 43. Thus, claims 35, 36, 38-42, and 44-46 are patentably distinguishable from Golley and Pruett for at least the same reasons as independent claims 34, 37, and 43, and Applicant respectfully requests reconsideration and withdrawal of the rejection of those claims based on Golley and Pruett.

**B. Independent Claims 49-53**

Independent claims 49-53 are directed to “[a] polymer product,” “[a] rubber product,” “[a] coating,” “[a] paper coating,” and “[a] paperboard coating,” respectively, each “comprising pulverized hydrous kaolin . . . .” For the reasons outlined above with respect to independent claim 1, Golley does not disclose pulverized hydrous kaolin. Pruett fails to overcome the above-noted deficiencies of the rejection of independent

claim 1 based on Golley. For at least these reasons, independent claims 49-53 are not *prima facie* obvious based on Golley and Pruett. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claims 49-53 based on Golley and Pruett.

## **V. Conclusion**

For at least the above-outlined reasons, pending claims 1-10 and 13-53 should be allowable. Accordingly, Applicant respectfully requests reconsideration of this application, withdrawal of the claim rejections, and allowance of all of claims 1-10 and 13-53

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6559.


Applicant respectfully submits that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether any of those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this Request and charge  
any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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By:   
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